

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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|--|---|
| In re Application of Karoly Nikolics et al. Serial No.: 10/755,190 Filed: January 9, 2004 | Group Art Unit: 1632 Examiner: To Be Assigned Confirmation No: 9193 Customer No: 09157 |
| Title: GLYCOPROTEIN HORMONE RECEPTOR MOLECULES | EXPRESS MAIL LABEL NO.: <u>EV 351 926 940 US</u> DATE OF DEPOSIT: <u>OCTOBER 27, 2004</u> |

**RESPONSE TO NOTICE REGARDING BENEFIT/PRIORITY CLAIM(S) AND REPEATED
REQUEST FOR CORRECTED FILING RECEIPT**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In a communication entitled "Notice Regarding Benefit/Priority Claim(s)" dated September 16, 2004 (copy enclosed) Applicants were notified that that the priority claim for the above-identified patent application incorrectly indicated that a prior filed application is an application filed under 35 U.S.C. 371. According to the Notice the "Office's records show that the prior-filed application is an application filed under 35 U.S.C. 111(a)." Accordingly, the Filing receipt mailed on September 16, 2004 lists Application Serial No. 07/781,153 filed on 10/31/1991 as a filing under 35 U.S.C. 111(a), and omits Applicants' priority claim to international application PCT/US90/02488, filed May 4, 1990, and application Serial No. 07/347,683, filed May 5, 1989, of which the PCT application is a continuation-in-part.

Applicants submit that Application Serial No. 07/781,153 was filed under 35 U.S.C. 371, as a national stage application of PCT/US90/02488, which, in turn, claims priority to application Serial No. 07/347,683.

In support, Applicants enclose copies of the

(i) the PCT Request, claiming priority to application Serial No. 07/347,683 filed on May 5, 1989, which resulted in PCT application PCT/US90/02488;

(ii) documentation of a Chapter II filing under 35 U.S.C. 371, based on PCT/US90/02488;

(iii) the Official Filing Receipt of Application Serial No. 07/781,153, which indicates that it is a national stage filing under 35 U.S.C. 371; and

(iv) a copy of the Official Filing Receipt mailed on September 16, 2004, with the requested corrections.

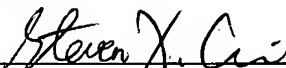
The issuance of a Corrected Filing Receipt is hereby requested.

In the event any fees are due in connection with the filing of these documents, the Commissioner is authorized to charge such fees to our Deposit Account No. 07-0630.

Respectfully submitted,

GENENTECH, INC.

Date: October 27, 2004

By: 
Steven X. Cui, Ph.D.
Reg. No. 44,637
Telephone No. (650) 225-8674

FILING RECEIPT

CORRECTED



UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

ASSISTANT SECRETARY AND COMMISSIONER

OF PATENTS AND TRADEMARKS

Washington, D.C. 20231

| SERIAL NUMBER | FILING DATE | GRP ART UNIT | FIL FEE REC'D | ATTORNEY DOCKET NO. | DRWGS | TOT CL | IND CL |
|---------------|-------------|--------------|---------------|---------------------|-------|--------|--------|
| 07/781,153 | 10/31/91 | 1812 | \$1,076.00 | 576P1 | 12 | 59 | 6 |

GENENTECH, INC.

ATTN: DARYL B. WINTER

460 POINT SAN BRUNO BLVD.

S. SAN FRANCISCO, CA 94080

Receipt is acknowledged of the patent application identified herein. It will be considered in its order and you will be notified as to the examination thereof. Be sure to give the U.S. SERIAL NUMBER, DATE OF FILING, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this transmittal.

Applicant(s)

KAROLY NIKOLICS, SAN CARLOS, CA; KEITH C. MC FARLAND,
BERKELEY, CA; DEBORAH L. SEGALOFF, IOWA CITY, IA;
PETER N. SEEBURG, HEIDELBERG, FED REP GERMANY.

CONTINUING DATA AS CLAIMED BY APPLICANT-

THIS APPLN IS A CIP OF 07/347,683 05/05/89

FOREIGN/PCT APPLICATIONS-PCT

PCT/US90/02488 05/04/90

FOREIGN FILING LICENSE GRANTED 01/30/92

TITLE

GLYCOPROTEIN HORMONE RECEPTOR MOLECULES

PRELIMINARY CLASS: 435

(see reverse)



UNITED STATES PATENT AND TRADEMARK OFFICE

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| APPL NO. | FILING OR 371 (c) DATE | ART UNIT | FIL FEE REC'D | ATTY. DOCKET NO | DRAWINGS | TOT CLMS | IND CLMS |
|------------|---------------------------|----------|---------------|-----------------|----------|----------|----------|
| 10/755,190 | 01/09/2004 | 1632 | 1730 | P0576P1C3 | 12 | 59 | 6 |

CONFIRMATION NO. 9193 ✓

09157
GENENTECH, INC.
1 DNA WAY
SOUTH SAN FRANCISCO, CA 94080

RECEIVED

FILING RECEIPT



OC000000013812650

SEP 28 2004

GENENTECH, INC.
LEGAL DEPT.

Date Mailed: 09/16/2004

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections, facsimile number 703-746-9195. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

Applicant(s)

Karoly Nikolics, San Carlos, CA; ✓
Keith C. McFarland, Berkeley, CA; ✓
Deborah L. Segaloff, Iowa City, IA; ✓
Peter H. Seeburg, Heidelberg, GERMANY; ✓

Assignment For Published Patent Application

Genentech, Inc.

Power of Attorney:

Deirdre L. Conley-36487

Domestic Priority data as claimed by applicant

This application is a CON of 09/877,804 06/07/2001 -
which is a CON of 08/207,814 03/07/1994 PAT 6,261,800 -
which is a CON of 07/781,153 10/31/1991 ABN -

Foreign Applications

which is a 371 of PCT/US90/02488 05/04/90
which is a CIP of 07/347,683 05/05/89

If Required, Foreign Filing License Granted: 09/14/2004

The number of your priority application, to be used for filing abroad under the Paris Convention is,
US10/755,190

Projected Publication Date: To Be Determined - pending completion of Corrected Papers

Non-Publication Request: No

Early Publication Request: No

Title

Glycoprotein hormone receptor molecules

Preliminary Class

424

**LICENSE FOR FOREIGN FILING UNDER
Title 35, United States Code, Section 184
Title 37, Code of Federal Regulations, 5.11 & 5.15**

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Office of Export Administration, Department of Commerce (15 CFR 370.10 (j)); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

NOT GRANTED

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).



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| APPLICATION NUMBER | FILING OR 371 (c) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|--------------------|------------------------|-----------------------|------------------------|
| 10/755,190 | 01/09/2004 | Karoly Nikolics | P0576P1C3 |

CONFIRMATION NO. 9193

09157
 GENENTECH, INC.
 1 DNA WAY
 SOUTH SAN FRANCISCO, CA 94080



OC000000013812623

Date Mailed: 09/16/2004

Notice Regarding Benefit/Priority Claim(s)

☐ **Improper Benefit Claim(s) to Prior-Filed Nonprovisional Application(s)**

The benefit claim(s) to prior-filed nonprovisional application(s) is improper because there is no specific reference for each prior-filed application that includes: (1) the identification of the prior-filed application by application number, or international application number and international filing date; and (2) a clear indication the relationship (i.e., continuation, divisional, or continuation-in-part) of the nonprovisional applications. For example, applicant should amend the specification to include a specific reference, such as "This application is a continuation of Application No. 10/---,--- filed ---." in the first sentence of the specification following the title.

Applicant should review each benefit claim submitted and, if appropriate, provide the proper reference to the prior-filed application(s) as required by 37 CFR 1.78. A proper relationship includes an identification of each nonprovisional application as a continuation, divisional or continuation-in-part application of the immediate prior-filed nonprovisional application for which a benefit is claimed under 37 CFR 1.78 in order to establish copendency throughout the entire chain of prior-filed applications. The specific reference must be included in the domestic priority information section of an application data sheet (37 CFR 1.76), or the specification must contain, or be amended to contain, such reference in the first sentence following the title.

Timeliness: The required reference for each benefit claim must be filed during the pendency of the instant application and within the later of: (1) four months from the actual filing date of the instant application, or the national stage commencement date if the instant application is a national stage application under 35 U.S.C. 371; or (2) sixteen months from the filing date of the prior-filed application. Failure to timely file the required reference is considered a waiver of any benefit claim, unless a grantable petition to accept an unintentionally delayed claim under 37 CFR 1.78(a), the surcharge set forth in 37 CFR 1.17(t), and the required reference are filed. See 37 CFR 1.78(a).

☐ **Improper Benefit Claim(s) to Prior-Filed Nonprovisional Application(s)**

The benefit claim(s) to prior-filed provisional application(s) is improper because the instant application was not filed within twelve (12) months from the filing date of the provisional application, and there is no indication of an intermediate nonprovisional application that is directly claiming the

benefit of the provisional application and filed within 12 months of the filing date of the provisional application. For example, applicant should amend the specification to include a specific reference, such as "This application is a continuation of Application No. 10/---,--- filed ---, which claims the benefit of U.S. Provisional Application No. 60/---,--- filed---." in the first sentence of the specification following the title.

Applicant should review each benefit claim submitted and, if appropriate, provide the proper reference to the prior-filed applications (including an indication of any intermediate nonprovisional application that is directly claiming the benefit of the provisional application and filed with 12 months of the filing date of the provisional application) as required by 37 CFR 1.78. The required reference must be included in the domestic priority information section of an application data sheet (37 CFR 1.76), or the specification must contain, or be amended to contain, such reference in the first sentence following the title.

Timeliness: The required reference for each benefit claim must be filed during the pendency of the instant application and within the later of: (1) four months from the actual filing date of the instant application, or the national stage commencement date if the instant application is a national stage application under 35 U.S.C. 371; or (2) sixteen months from the filing date of the prior-filed application. Failure to timely file the required reference is considered a waiver of any benefit claim, unless a grantable petition to accept an unintentionally delayed claim under 37 CFR 1.78(a), the surcharge set forth in 37 CFR 1.17(t), and the required reference are filed during the pendency of the instant application.

☐ **Improper Priority Claim(s) to Prior-Filed Foreign Application(s)**

The instant application was not filed within twelve (12) months from the filing date of the prior-filed foreign application, and there is no benefit claim to an intermediate nonprovisional application filed within 12 months of the filing date of the foreign application. Applicant should review each priority claim submitted and, if appropriate, provide the proper reference to any intermediate nonprovisional application filed within 12 months of the filing date of the foreign application in compliance with 37 CFR 1.78, or delete the priority claim. The required reference to an intermediate nonprovisional application must be included in the domestic priority information section of an application data sheet (37 CFR 1.76), or the specification must contain, or be amended to contain, such reference in the first sentence following the title.

Timeliness: The required reference for the benefit claim to an intermediate nonprovisional application must be filed during the pendency of the instant application and within the later of: (1) four months from the actual filing date of the instant application, or the national stage commencement date if the instant application is a national stage application under 35 U.S.C. 371; or (2) sixteen months from the filing date of the prior-filed application. Failure to timely file the required reference is considered a waiver of any benefit claim, unless a grantable petition to accept an unintentionally delayed claim under 37 CFR 1.78(a), the surcharge set forth in 37 CFR 1.17(t), and the required reference are filed.

☐ **Benefit Claims to More Than 400 Prior-Filed Applications**

The Office's automated system to record and capture benefit claims is only capable of recording benefit claims for 400 prior-filed applications. Therefore, the Office is unable to generate a filing receipt containing benefit claims for more than 400 prior-filed applications even though applicant is entitled to submit benefit claims for more than 400 prior-filed applications. Accordingly, applicant should not request a corrected filing receipt to include benefit claims for more than 400 prior-filed applications.



Prior-Filed Nonprovisional Application has been Improperly Indicated as a National Stage (35 U.S.C. 371) Application

Applicant submitted a benefit claim to a prior-filed nonprovisional application and improperly indicated that the prior-filed application is a national stage application under 35 U.S.C. 371. The Office's records show that the prior-filed application is an application filed under 35 U.S.C. 111(a). The Office has entered the benefit claim to the prior-filed application as a benefit claim to an application filed under 35 U.S.C. 111(a). Any request for a corrected filing receipt to include the indication that the prior-filed application is a national stage application will not be granted unless applicant supplies evidence that the prior application was in fact a national stage application. Accordingly, applicant should not submit such request without such evidence. Applicant should submit an amendment (or an application data sheet (ADS) if the benefit claim was submitted in an ADS) to delete the indication that the prior-filed application is a national stage application.

For more information and examples on benefit claims, please see Claiming the Benefit of a Prior-Filed Application under 35 U.S.C. 119(e), 120, 121, and 365(c), 1268 Off. Gaz. Pat. Office 89 (March 18, 2003), which is available on the USPTO website at <http://www.uspto.gov/web/offices/com/sol/og/2003/week11/patbene.htm>, and the Manual of Patent Examining Procedure (MPEP) §§ 201.11 and 201.14.

PART 1 - ATTORNEY/APPLICANT COPY